

Sallmann et al. disclose pharmaceutical acceptable salts of diclofenac including sodium, potassium, pyrrolidine, morpholine and 2-piperidino-ethanol. While Sallmann et al. recognize the desirability of formulating a diclofenac type compound as a water soluble salt, only the sodium salt of diclofenac type compounds is taught as water soluble. See column 24, lines 35-39. Yet for all practical purposes the sodium salt of diclofenac is not water soluble to the extent noted in the Sallmann et al. patent (preferably 0.5 to 5%, in aqueous solution). With reference to page 3, lines 3-12, of the instant specification, there is data which illustrates the comparative water solubility of certain salts of diclofenac. At line 10, the sodium salt of diclofenac is soluble in water to the limited extent of 1.36% (w/v). However, surprisingly and unexpectedly, the claimed hydroxyethylpyrrolidine salt of diclofenac is soluble to an extent greater than 50% (w/v).

Evidence that a compound is unexpectedly superior in one of a spectrum of common properties, as here, is enough to rebut obviousness. In re Chupp, 816 F.2d 643, 646, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987); In re Ackermann, 444 F.2d 1172, 1176, 170 U.S.P.Q. 340, 343 (C.C.P.A. 1971). Clearly, there is no suggestion in Sallmann et al. that enhanced water solubility could be achieved by using the selected cyclic organic base of the formula:



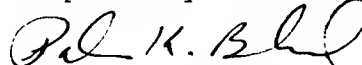
The unforeseeable high water solubility of the presently claimed compounds allows for ready preparation of water soluble therapeutic composition useful for oral administration. The administration of an aqueous solution of diclofenac avoids much of the risks of gastrolesion often associated with the water insoluble diclofenac salts. See specification page 2, lines 7-15.

Indefiniteness Rejection

In the Office Action, claim 8 was rejected under 35 U.S.C. § 112, first and second paragraphs, as indefinite and non-enabling for use of the term "containing". While Applicants do not agree that such term is objectionable, new claim 14 employs the term "comprising".

In view of the foregoing amendments and remarks, Applicants respectfully submit that the claims are in proper form and condition for allowance. Applicants respectfully request that the claims be allowed and the case advanced to issue. The examiner is encouraged to telephone the undersigned should she believe Applicants could be of assistance in placing the application in even better condition for issue.

Respectfully submitted,



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